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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/054,951 04/27/93 CLEMENT

J 26050111REI

HASTINGS, K

EXAMINER

13M1/1104

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1303

DATE MAILED:
11/04/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

ART UNIT	PAPER NUMBER
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This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1 - 18, 49-52 Claims _____ are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 19-48 have been cancelled.

3. Claims _____ are allowed.

4. Claims 1 - 18, 49-52 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed on _____, has been approved. disapproved (see explanation).

12. Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit 1303

This reissue application was filed without an offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect which is required. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before the reissue application can be allowed. See 37 C.F.R. § 1.178.

Claims 49-52 are rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period.

New claim 49 is broader than the patent claims in many respects; claim 49

- 1) fails to specify "at room temperature" in step (b)
- 2) fails to claim mechanical energy levels of steps (a) and (c) (1) and (c) (2)
- 3) fails to claim temperature range - (c) (1) and (c) (2)
- 4) fails to claim alkaline pH of at least 9-(c) (1) and (c) (2).

This broadening reissue is considered not to be timely filed since the parent reissue, SN. 07/600,012, was not a broadening reissue - SN 600,012 lacked basis for reissue because it was not for the invention disclosed in the original patent. Thus

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applicant cannot rely upon the filing date of SN 600,012 as being a broadening reissue filed within the two year statutory period. Also it is noted that by applicant's own admission in the oath, he did not discover this "error" until April 1993 - almost 5 years after the patent issued.

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 C.F.R. § 1.175(a)(5).

The reissue oath or declaration filed with this application is defective because it fails to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5).

The errors set forth by applicant are not errors correctable by reissue since applicant is attempting to recapture claimed subject matter deliberately narrowed by applicant during original prosecution in order to obtain the patent. See MPEP 1412.02 and Mentor Corp v. Coloplast Inc. CAFC 27 USPQ 2d 1521. Applicant, during original prosecution, narrowed the claims to set forth specific mechanical energy levels, room temperature cleaning, and alkaline pH of at least 9 in order to overcome rejections made in that case. Applicant cannot now call these errors. It is not correctable by reissue. (applicant could have filed a

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continuation application to pursue claims of broader scope than those allowed in the original prosecution.) Note page 3 of the reply brief filed 6-1-92 in SN 600,012 even admits that the very specific process parameters of claim 1 were added during original prosecution in order to distinguish over the prior art.

Further the oath does not specify each change from the original patent claims as an error and how/why each error arose/occurred. Applicant fails, for example only, to discuss why specifying "at room temperature" for step (b) was an error. Each change represents acknowledgement of an error and must be referred to in ~~the~~ the declaration. MPEP 1414, 1444.

Further, it does not seem that applicant can properly claim miscommunication difficulties because of his limited understanding of U.S. patent law as a reason for how the errors occurred. A lapse of almost five years from issuance of the original patent until applicant finally met and had "detailed review" of this situation with the attorneys of record in this case does not appear to be sufficient basis for how/why the errors arose which are the basis for reissue in this case.

Claims 1-18 and 49-52 are rejected under 35 USC 251 as lacking basis for reissue, since recapture is not an error correctable by reissue. See above. Also, as stated in Hewlett

Serial No. 08/054, 951

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Packard v Bausch & Lomb 11 USPQ 2d 1758, "reissue is not intended to give the patentee simply a second chance to prosecute the patent application... Section 251 does not authorize a patentee to re-present his application. Insight resulting from hindsight on the part of new counsel does not, in every case, establish error".

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(1). Correction of the following is required: the specification does not appear to explicitly describe the limitations of claims 1 and 50, re: below 50 KW.H/Ton, above 50 KW.H/Ton. The "below 50" and the range of 50-100 kWh/Ton~~s~~ for steps a, (c) (1) and (c) (2) were in original claims 3, 6 of the application 06/482,623, thus these limitations are not new matter, but it does appear the specification should be amended to provide proper basis for same.

Any inquiry concerning this communication should be directed to Exr. Hastings at telephone number (703) 308-0470.

Karen M. Hastings
PRIMARY EXAMINER
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11-2-93

Exr. Hastings; nrd
October 28, 1993